

REMARKS

Claims 1, 2 and 7 through 38 are pending in this Application, of which claims 7 through 38 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

Accordingly, claims 1, 2 and 7 through 16 are active.

Claims 1, 2, 7, 8 and 11 through 16 have been amended and claims 3 through 6 cancelled. Care has been exercised to avoid the introduction of new matter. In this respect, Applicants note that the limitations of claims 3 and 5 have been incorporated into claim 1, the limitations of claims 4 and 6 have been incorporated into claim 2, the dependencies of claims 7 and 8 appropriately changed, and claims 11 through 16 placed in independent form. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 through 16 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Davey.

Claims 1 through 16 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Smalley.

Each of the above rejections under 35 U.S.C. § 102 is traversed.

Claim 1 defines a structure in which a bonding material bonds the polymer wrapping the first structure (carbon nanotube structure) to the second structure. **Claim 2** defines a structure in which a bonding material bonds the polymer wound around the first structure (carbon nanotube structure) to the second structure. Neither Davey nor Smalley discloses or suggests a structure as defined claims 1 and 2.

Specifically, Davey discloses a composition comprising nanotubes and organic material having a coiling structure. Smalley teaches carbon nanotubes having polymer wrapped about the nanotubes. However, even if the nanotubes aggregate in the structure disclosed by Davey or

Smalley, polymer, wound about the nanotubes, would be interposed between the nanotubes without exception. In other words, neither Davey nor Smalley discloses or suggests a structure in which a bonding material bonds the polymer wrapping the first structure to the second structure as in claim 1, or a structure wherein a bonding material bonds the polymer wound around the first structure to the second structure as in claim 2.

Claim 11 specifies that the polymer wrapping the first structure includes a polypeptide.

Claim 12 specifies that the polymer wound around the first structure includes a polypeptide.

Neither Davey nor Smalley discloses or suggests the use of a polypeptide as a polymer wound about the nanotubes.

Claims 13 and 14 specify that the second structure is a base material. In contrast, Davey and Smalley merely indicate a structure in which carbon nanotubes are bonded with each other. Davey and Smalley neither disclose nor suggest a structure in which the first structure (carbon nanotube structure) is bonded with a base material.

Claim 15 and 16 specify that the second structure is a metal film. Davey and Smalley merely indicate a structure in which carbon nanotubes are bonded with each other. Davey and Smalley neither disclose nor suggest a structure in which the first structure is bonded with a metal film.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). The above argued differences between the claimed structures and the structure

Application No.: 10/751,524


disclosed by each of Davey and Smalley undermine the factual determination that either Davey or Smalley discloses a bonded structure identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 16 under 35 U.S.C. § 102 for lack of novelty as evidenced by Davey, and the imposed rejection of claims 1 through 16 under 35 U.S.C. § 102 for lack of novelty as evidenced by Smalley, are not factually viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome, and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:JNS:ntb
Facsimile: 202.756.8087
Date: April 4, 2006

**Please recognize our Customer No. 20277
as our correspondence address.**